

REMARKS

I. Summary of the Office Action and this Reply

Claims 1-11, 13-16 and 28-31 are pending in the application. Claims 12, 17-27 and 32-53 have been withdrawn in view of Applicants' Response to Restriction Requirement filed November 18, 2003; Claim 31 has been rejoined by the Examiner.

The Examiner has rejected claims 1-3 and 28-30 under U.S.C. § 102(b), asserting that such claims are anticipated by U.S. Patent No. 5,267,963 to Bachynsky ("Bachynsky"). The Examiner has rejected claims 4-7 and 31 under 35 U.S.C. § 103(a), asserting that such claims are obvious over Bachynsky in view of U.S. Patent No. 5,201,716 to Richard ("Richard"). Claims 8-11 and 13-16 stand rejected under 35 U.S.C. § 103(a) over various combinations of Bachynsky, Richard, Wozencroft publication WO/93/01851 ("Wozencroft") and U.S. Patent No. 4,894,054 to Miskinyar ("Miskinyar").

In this Reply, claims 1, 3 and 28 are amended. No new matter is added.

II. Response to 102 Rejections

The Examiner has rejected claims 1-3 and 28-30 under U.S.C. § 102(b), asserting that such claims are anticipated by Bachynsky.

A rejection under 35 U.S.C. § 102 is proper only if each and every element of the claim is found in a single prior art reference. MPEP § 2131.

Claims 1 and 28

Independent claim 1 is directed to a needle device including a housing having a

base for placement against a surface of a needle penetrating site. The needle device includes "a retraction mechanism that moves the needle to the retracted position responsive to releasing the base from the site surface."

Bachynsky discloses a medication injection device including a sliding cam mechanism that is advanced by a resiling spring. The sliding cam mechanism 5 has a first cam surface 6 that advances a syringe 11 needle 12, and a second cam surface 7 that advances a syringe plunger 13, as the spring 9 resiles and pulls that cam mechanism past the syringe barrel 14. See Figures 1A, 1B; col. 4, lines 31-57. In addition, the sliding cam mechanism 5 includes a third cam surface 8 that pulls the syringe barrel 14 and needle 12 into a retracted position as the spring 9 continues to resile and pulls the cam mechanism 5. See Figures 1A, 1B, 2; col. 5, lines 13-22.

Thus the advancing and retracting of Bachynsky's needle occurs in a single action of the resiling spring; there is no intermediate breakpoint between advancing of the needle and the retracting of the needle. Further, the advancing and retracting of the needle occurs regardless of whether the device's housing 20/curved section 19 is abutting a bodily injection site; all that is required is release of the trigger mechanism 4. Further still, the needle retraction occurs automatically before, and/or without any need for, removal of the device's housing 20/curved section 19 from a position in which it abuts a bodily injection site. Accordingly, the needle retraction is completely independent of any release of the base from the site. Thus, Bachynsky's needle retraction is not responsive to release of the base from the site.

In contrast to the claimed invention, the retraction mechanism of claim 1 moves the needle to the retracted position responsive to releasing the base from the site

surface. This element is neither taught nor suggested by Bachynsky.

Independent claim 28 includes a similar recitation, namely, "a retraction mechanism that automatically moves the needle from the extended position to the retracted position in response to removal of the base from the surface." This element is neither taught nor suggested by Bachynsky.

For at least this reason, reconsideration and withdrawal of the rejection of claims 1 and 28 are requested respectfully.

Claims 2-3 and 29-30

Claim 2-3 and 29-30 depend from claims 1 and 28, respectively, and are likewise patentable for at least this reason.

III. Response to 103 Rejections

The Examiner has rejected claims 4-11, 13-16 and 31 under 35 U.S.C. § 103(a), asserting that such claims are obvious over various combinations of Bachynsky, Richard, Wozencroft and Miskinyar.

A section 103 rejection is proper only if all claim limitations are taught or suggested by the cited art. MPEP § 2143.

Claims 4-11 and 13-16

Claims 4-11 depend from claim 1 and are thus allowable as depending from an allowable claim, as discussed above with reference to claim 1.

Further, claim 4 recites that "the retraction mechanism includes a trigger member

... having a first portion adapted to engage the actuator and a second portion adapted to contact the [needle penetrating] site surface." The Examiner acknowledges that Bachynsky fails to suggest such a trigger member. Applicants agree.

However, the Examiner asserts on page 4 of the Action that Richard discloses such a trigger member. Applicants respectfully disagree. The needle of claim 4 is most analogous to the needle 22 of Richard, and is not at all analogous to the "needle" portion 28 that breaks a septum seal of a blood collection receptacle. See Figure 3. The septum seal of Richard is not a surface of a needle penetrating site. Further, there is no teaching or suggestion whatsoever in Richard of a trigger member that engages a bodily surface of a needle penetrating site.

For at least this additional reason, reconsideration and withdrawal of the rejection of claim 4 are requested respectfully. Claim 6 recites that "the base further includes a second opening through which the second portion of the trigger member is adapted to contact the site surface." This also is neither taught nor suggested by Richard, for reasons similar to those set forth above for claim 4.

Claims 7-11 depend from claim 4 and are likewise patentable for at least this additional reason.


Claim 31

Claim 31 depends from claim 28 and is thus allowable as depending from an allowable claim, as discussed above with reference to claim 28.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe claims 1-11, 13-16 and 28-31 to be patentable and the application in condition for allowance. Applicants respectfully request issuance of a Notice of Allowance. If any issues remain, the undersigned requests a telephone interview prior to the issuance of an action.

Respectfully submitted,



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